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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/828,967	04/21/2004	Thomas Ostrowski	12287	5365

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EXAMINER

KEYS, ROSALYND ANN

ART UNIT PAPER NUMBER

1621

DATE MAILED: 03/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/828,967

Applicant(s)

OSTROWSKI ET AL.

Examiner

Rosalynd Keys

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☒ Claim(s) 4-9 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>8/30/04</u> . | 6) <input type="checkbox"/> Other: ____.  |

**DETAILED ACTION**

***Status of Claims***

1. Claims 1-9 are pending.  
Claims 1-3 are rejected.  
Claims 4-9 are objected to and have not been further treated on the merits.

***Information Disclosure Statement***

2. The information disclosure statement (IDS) submitted on August 30, 2004 has been considered by the examiner.

***Claim Objections***

3. Claims 4-9 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from any other multiple dependent claim. See MPEP § 608.01(n). Accordingly, the claims 4-9 have not been further treated on the merits.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

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2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pazos et al. (US 5,689,012) in view of Herold et al. (US 4,355,188).

Pazos et al. teach steps A and B of the instant invention (see entire disclosure, in particular column 5, lines 55-67; column 7, line 8 to column 10, line 25; column 11, line 41 to column 12, line 34; column 13, line 30 to column 16, line 65 and examples 1, 6 and 7).

Pazos et al. fail to disclose steps C, D and E. However, Pazos et al. do teach that the polyol product produced by their method may be diverted to a second reactor to cap the product (see column 12, lines 30-34).

Herold et al. teach a process for ethylene oxide capping a polyether polyol, which has been prepared with a double metal cyanide catalyst, by treating the catalyst residue contained in the polyol with a strong base, i.e., step C (see column 2, line 55 to column 3, line 11). Ethylene oxide may be added during reaction of the alkali metal and the catalyst residues are removed from the polyether polyol, i.e., steps D and E (see column 4, lines 3-45). Herold et al. do not disclose that the ethylene oxide is reacted in a continuously operating reactor. However, the ordinary skilled artisan would have been motivated to employ a continuous operating reactor in order to obtain increased throughput. Further, it is well established that

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batch and continuous processes are not patentably distinct. See *In re Dilnot*, 319 F. 2d 188, 138 USPQ 248 (CCPA 1963).

One having ordinary skill in the art at the time the invention was made would have found it obvious to employ the polyol capping process of Herold et al. with the polyether process of Pazos et al. because at the time of Pazos et al. invention the capping process of Herold et al. was a well known method of end capping a polyether polyol which had been produced using a dmc catalyst. Further, the skilled artisan would have been motivated to utilize the capping process of Herold et al. for the polyether polyol of Pazos et al. because it would allow the skilled artisan to remove any double metal cyanide residues contained therein, thus making it more desirable for use in making polyurethane products.

8. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaushiva et al. (US 7,005,552 B2) in view of Pazos et al. (US 5,689,012).

Kaushiva et al. teach steps C, D and E (see entire disclosure, in particular column 6, line 1 to column 8, line 46).

Kaushiva et al. fail to disclose steps A and B. However, Kaushiva et al. teach that any polyol produced by DMC catalysis may be used in their invention (see column 6, lines 9-15).

Pazos et al. teach preparation of a polyether polyol by DMC catalysis (see entire disclosure). The polyether polyol is produced using the claimed steps A and B (column 5, lines 55 to 67 and column 9, line 10 to column 10, line 25).

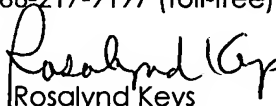
One having ordinary skill in the art at the time the invention was made would have been motivated to utilize the process of Pazos et al. to prepare the polyether polyols for use in the process of Kaushiva et al. because the process of Pazos et al. would allow one to prepare polyether polyols having the desired characteristics of the polyether polyols useful in the process of Kaushiva et al. (see column 6, lines 9-52 of Kaushiva et al. and column 4, lines 49-64 of Pazos et al.). For example low levels of unsaturation and nominal functionality.

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9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rosalynd Keys whose telephone number is 571-272-0639. The examiner can normally be reached on M-W & F 4-10pm; H 5:30am-5pm; Sat 8am-1pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Rosalynd Keys  
Primary Examiner  
Art Unit 1621

March 9, 2006